

REMARKS

Contemporaneously with the Request for Continued Examination (RCE), the Applicants respectfully submit this Request For Reconsideration which responds to the points raised in the Office Action mailed on 28 November 2007 for the above-identified patent application. In the present Request, no claims have been amended, added, or canceled.

In the Office Action of 28 November 2007, the Examiner rejected claims 1-10 of the present application under 35 U.S.C. § 102(e) as being anticipated by Islam et al. (U.S. Patent Application Publication No. 2006/0104211 A1). In addition, the Examiner rejected claims 11-30 of the present application under 35 U.S.C. § 103(a) as being unpatentable over Islam et al. In response, the Applicants respectfully disagree with the Examiner's rejections and submit that all pending claims are allowable over the prior art of record for at least the following reasons.

For proper rejections under 35 U.S.C. § 102(e) and § 103(a), the prior art must teach or suggest each and every limitation of the claims. In addition, for rejections under 35 U.S.C. § 103(a), there must be a proper obviousness/non-obviousness assessment that includes some adequate reasoning and/or demonstration that one ordinarily skilled in the art would have combined the teachings of the references to produce that which is claimed.

For one, the prior art relied upon fails to teach or suggest each and every limitation of the claims. In particular, the prior art relied upon fails to teach or suggest a "flow control process" of a wireless communication network. Note that the Examiner must construe claim terms as broadly as is reasonable. In particular, claims must be "given their broadest reasonable interpretation consistent with the specification" (Emphasis Added) See *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). Claims are given their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am.*

Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004) (Emphasis Added).

In the present case, a “flow control process” is a term of art of which one ordinarily skilled in the art would readily appreciate. A flow control process of a wireless communication network is operative to terminate data communication to a mobile station based on detection of an out-of-coverage condition between the mobile station and the wireless communication network. This meaning is clearly supported and consistent with the present specification. See e.g. page 4 at lines 3-17 and page 9 at lines 8-31 through page 10 at lines 1-10.

In the rejection of claims (e.g. claim 1), the Examiner merely directs the Applicants to column and line numbers in the reference. Specifically, the Examiner makes reference to page 1, paragraph 8 and page 4, paragraph 49. However, there is no mention of a “flow control process” or similar process in those passages, and there is no functional description corresponding to the same either. The Examiner articulates little if anything to explain the position taken.

As apparent, the Examiner appears to ignore the meaning and the basic limitations associated with a “flow control process” of a wireless communication network. If the Examiner is broadly interpreting the meaning of “flow control process” to be different from how one ordinarily skilled in the art would interpret such terminology, the Applicants respectfully submit that such interpretation is unreasonable. If the Examiner is implicitly arguing that a “flow control process” is inherent in the prior art, the Examiner has failed to articulate any reasoning for any such inherency in order to properly establish a prima facie case of anticipation or obviousness.

In addition, with respect to the rejection of claim 1, the Examiner indicates that the recited “network processor” of the network is “inherent in mobile devices” (see page 3 at lines 8-9 of the Office Action). For one, this statement is incorrect, as a “network processor” is known to one ordinarily skilled in the art as being part of a network and not a mobile device. Second, the Examiner’s statement suggests that a “flow control

process” and any bypassing/allowing thereof relates to that which is performed within the mobile device and not the wireless network – which is also incorrect.

Even further, it follows that the prior art utilized in the rejections further fails to teach or suggest the step of “causing *the flow control process to be bypassed* for the mobile station based on the indication indicating that the mobile station or the application thereof utilizes the always-on connection for the data service” and the other step of “*otherwise allowing the flow control process to be performed* for the mobile station based on the indication indicating that the mobile station or the application thereof fails to utilize the always-on connection.”

Based on the above, all pending claims are allowable over the prior art of record. Other reasons for allowability of the independent and dependent claims are apparent to those of ordinary skill in the art, but not articulated herein due to the already-provided reasons for allowability.

For proper rejections under 35 U.S.C. § 103(a), there must also be a proper obviousness/non-obviousness assessment that includes some adequate reasoning and/or demonstration that one ordinarily skilled in the art would have combined the teachings of the references to produce that which is claimed. When considering various prior art teachings for an obviousness/non-obviousness determination under §103,

the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *Graham vs. John Deere Co. of Kansas City*, 383 U.S. 1, pp 17-18 (1966).

In this analysis, a functional approach may be taken which asks whether the improvement of the presented invention is more than a predictable use of prior art elements according to their established functions. It is also helpful and instructive to consider whether there is any teaching, suggestion, or motivation to combine the teachings of the references,

either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art, in a flexible and non-rigid manner. The reason or evidence of a motivation to combine teachings need not be found explicitly in the prior art references, as one may also “look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art.” *KSR Int’l Co. v. Teleflex Inc. et al.*, 127 S.Ct. 1727, at 1740-41.

In the present case, the Examiner states in the obviousness rejections that

Islam fails to explicitly disclose a Packet Control Function (PCF) operate to perform the functions described above in the rejection of claim 1.

However, it is known in the art that the Packet Control Functions are utilized in the art to incorporate packet control functions in a radio access network, so as to provide means for controlling the packets as they are transmitted through a network.

The Applicants respectfully disagree with the rejections and reasons provided for such rejections. In general, the Examiner’s § 102 and 103 rejections in the Office Action are conflicting. The Examiner indicates that the “network processor” of the network is “inherent in mobile devices” (see page 3 at lines 8-9 of the Office Action) in the rejection of claim 1. This indication suggests that the “flow control process” and any bypassing/allowing thereof relates to that which is performed within the mobile device and not the wireless network. In the rejection of claims 11-30, however, the Examiner indicates that it would have been obvious that the flow control process be part of the network (e.g. the Packet Control Function). The Examiner provides no reasoning to support the apparent discrepancy or differences regarding where the “flow control process” is performed, and how it could be performed in both/either the mobile device and/or the wireless network. The Applicants submit that this discrepancy exists because there is no adequate reason why one ordinarily skilled in the art would have modified the Islam reference to produce that which is claimed.

Finally, the Applicants submit that U.S. Patent Application Publication No. US2006/0104211 A1 does not qualify as prior art for any obviousness rejection under 35 U.S.C. § 103(a). Under 35 U.S.C. § 103(c), such prior art shall not preclude patentability where the subject matter of the reference and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

In the present case, the subject matter of US2006/0104211 A1 and the claimed invention were owned by the same person or subject to an obligation of assignment to the same person at the time the claimed invention was made. Specifically, the present application was filed on 27 February 2004 and claims priority to a U.S. provisional application filed on 09 February 2004. The present application was assigned from Willey et al. (i.e. all inventors of the present application) to Research In Motion Limited no later than 16 April 2004. The claimed invention of the present application was subject to an obligation of such assignment to Research In Motion Limited at the time the claimed invention was made. In addition, a patent application having Application No. 10/533,957 and associated with US2006/0204211 A1 was assigned to Research In Motion Limited no later than 25 April 2005. The patent application 10/533,957 was a National Stage filing of a PCT application filed on 23 June 2003, which was based on an earlier filed U.S. provisional patent application 60/423,355 filed on 04 November 2002. The patent application having Application No. 10/533,957 and associated with US2006/0104211 A1 was assigned or subject to an obligation to assignment to Research In Motion Limited at the time the claimed invention was made. Further evidence of such assignment or obligation to assign will be provided upon request if necessary.

Thus, under 35 U.S.C. § 103(c), U.S. Patent Application Publication No. US2006/0104211 A1 does not qualify as prior art for any present or future obviousness rejection under 35 U.S.C. § 103(a).

Based on the above, the Applicants respectfully submit that all pending claims are novel and non-obvious over the prior art of record. The Applicants respectfully request the Examiner to withdraw all claim rejections and allow the application as is appropriate.

Thank you. The Examiner is welcome to contact the undersigned if necessary to expedite prosecution of the present application.

Respectfully submitted,

/John J. Oskorep/

Date: 30 January 2008

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